



THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	MAIL STOP PETITIONS
Youn-joon Sung et al.)	
Application No.: 10/813,157)	Group Art Unit: 2828
Filed: March 31, 2004)	Examiner: MARCIA A. GOLUB
For: LASER DIODE AND METHOD OF)	Confirmation No.: 4476
MANUFACTURING THE SAME USING)	
SELF-ALIGN PROCESS)	
)	

**PETITION TO WITHDRAW RESTRICTION REQUIREMENT PURSUANT TO 37
C.F.R. §1.144**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition for review and withdrawal of the requirement restricting claims 1-23 into two inventions. Namely, claims 1-10 were restricted to a first invention drawn to a laser diode, and claims 11-23 were restricted to a second invention drawn to a method of manufacturing a laser diode. This requirement was set forth in an Office Action dated December 18, 2006. Applicants requested reconsideration and withdrawal of this requirement in a response filed January 17, 2007. The requirement was repeated and made final in an Office Action dated March 13, 2007.

MPEP §803 sets forth two criteria for a proper restriction requirement. The first being that the inventions must be independent or distinct as claimed. The second criterion establishes that there would be serious burden on the Examiner if restriction were not required. MPEP §811 adds, "the Examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops."

Regarding the first criterion, Applicants acknowledge that the inventions as suggested in the restriction may have distinct art classifications. However, even under this assumption, the importance of the first criterion is minimal when weighed against the prior search and examination of all claims in previous Office Actions.

Regarding the second criterion, Applicants respectfully submit that a serious burden does not exist because two previous office actions on the merits have been issued, and Applicants response has not provided a situation where a need for a restriction requirement developed. In other words, there can be no serious burden for the *continued* examination of the same subject matter.

In a non-final Office Action dated February 28, 2006, the subject matter recited in the originally filed claims 1-23 was searched and rejected under 35 U.S.C. §102. Applicants filed a response including a claim amendment that on May 23, 2006. In a second non-final Office Action issued on August 15, 2006 and in response to Applicants' claim Amendment, the subject matter recited in claims 1-23 was searched and rejected under 35 U.S.C. §103. Applicants point out that in each Office Action, the same prior art reference was used to reject the claims. In response to the second non-final Office Action, Applicants filed a Request for Reconsideration on November 7, 2006, which included no claim amendments.

Given the prosecution history, two factual assertions can be made with certainty. First, pending claims 1-23 have been searched and examined at least twice. Second, Applicants' Request for Reconsideration maintained the presentation of the claims prior to the second non-final Office Action. Hence, Applicants submit that no need has developed that justifies requiring a restriction of the claims.

Applicants acknowledge that the current Examiner who issued the Restriction Requirement is different from the previous Examiner who issued the two prior Office Actions. This development, however, should not justify a claim restriction. As stated in MPEP §704, "full faith and credit should be given to the search and action of the previous Examiner

unless there is a clear error in the previous action or knowledge of other prior art." Even if the previous Examiner could have properly restricted the claims prior to issuing the first Office Action, Applicants should not now be penalized for circumstances of which it had no control. In fact, each Office Action issued in this case has been supervised and endorsed by the same primary examiner. Regarding the supervision of assistant examiners, MPEP §707.01 states "...it is the duty of the primary examiner to review the application thoroughly...[t]he primary examiner may indicate the action to be taken, whether restriction or election of species to be required, or whether the claims are to be considered on their merits." Based on the prior office actions, the primary examiner apparently found no need to restrict the claims. These events provide further evidence that the search and consideration of all claims present no serious examination burden.

In response to Applicants traversal of the restriction, the current Examiner maintains the restriction on the basis that method claims 11-23 could be classified in a different class from the device claims 1-10, and thus examined in a different art unit (See Office Action dated March 13, 2007, pg. 2). Even assuming arguendo that this assertion is true, the previous Examiner seemingly has already searched the requisite classes and identified the most relevant art. The current Examiner has shown neither that "clear error" exists in the prior examination nor that knowledge of other prior art exists. Rather, it appears the current Examiner has disavowed the previous search and made the restriction final based merely on personal preference. Applicants find no evidence that "clear error" arises, when an examiner searches and examines claims that could be examined in a different art unit.

In sum, the subject matter recited in claims 1-23 has been searched and considered at least twice under the supervision of the same primary examiner. The current Examiner has not apparently given full faith and credit to the search by a previous Examiner nor identified clear errors with respect to the previous examination. Accordingly, Applicants submit that the requirement for restriction is improper. Withdrawal of the restriction

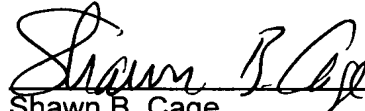
requirement, as applied to claims 11-23, and reinstatement of these claims in the application is respectfully submitted to be in order.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: May 8, 2007

By:


Shawn B. Cage
Registration No. 51522

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620